

REMARKS

This Amendment is in response to the Office Action dated June 6, 2007.
In the Office Action:

1. Claims 21-31 were rejected under 35 USC §101; and
2. Claims 1-31 were rejected under 35 USC §102.

By this Amendment, claims 15 and 21 are amended. Currently pending claims 1-31 are believed allowable, with claims 1, 14, 15 and 21 being independent claims.

REJECTIONS UNDER 35 USC §101

Claims 21-31 were rejected under 35 USC §101 as allegedly directed to non-statutory subject matter. Claims 21-31, as originally written, claim "computer readable program codes" coupled to "tangible media". According to the Examiner, "A computer program product is not tangibly embodied in a manner so as to be executable because the applicant does not clearly define a tangible media in the specification." Office Action, pg. 2.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, "When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, pp. 53-54 (Oct. 26, 2005) (http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

In the present application, claim 21 is amended to recite, "A computer program product embodied in computer memory." Support for this amendment can be found at least at Fig. 1, item 116. Thus, claim 21 provides for a computer program in conjunction with a physical structure, namely computer memory. Furthermore, the claim is directed to statutory subject matter and is believed to overcome the rejections under 35 USC §101.

Claims 22-31 are dependent on and further limit claim 21. Since claim 21 is believed to be directed to statutory subject matter, claims 22-31 are likewise believed to be directed to statutory subject matter.

REJECTIONS UNDER 35 USC §102

Claims 1-31 were rejected under 35 USC §102(e) as allegedly anticipated by U.S. Patent Document No. 2004/0230459 (Dordick).

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency. *See generally, In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Claim 1

Claim 1 recites, in part, "A method for embedding an agreement between a device provider and a device user in a device." In rejecting claim 1, the Office Action argues Dordick anticipates a method for embedding an agreement between a device provider and a device user in a device. The Examiner cites figure 1 and paragraph 36 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Figure 1 of Dordick illustrates various components of an environment embodying a service agreement 110 between a service provider 104 and a service purchaser 106. There is no teaching or suggestion of embedding an agreement between a device provider and a device user in a device.

Paragraph 36 of Dordick states,

At monitoring operation 308, the insurance provider monitors at least one insurance risk metric via the communication network. As used herein, an insurance risk metric is a measurable parameter that helps predict the likelihood that the specified event or events will occur in the future. Thus, what the insurance risk metric is depends upon what the specified events in the insurance policy are. For example, if the specified event is network unavailability for a service provider, the insurance risk metrics may include, but are not limited to, the amount of data transferred to and from a service provider, the amount of disk space utilized by a service provider's customers, the number of logged calls to a technical support phone number, the number of customers

being serviced by the service provider, the number of service agreements entered into by the service provider, and so on..

Paragraph 36 of Dordick describes a monitoring operation by the insurance provider. This paragraph details measuring an insurance risk metric that helps predict the likelihood that the specified event or events will occur in the future. It is clear from a reading of paragraph 36 that there is no teaching or suggestion of embedding an agreement between a device provider and a device user in a device.

For at least these reasons, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 1. Thus, claim 1 is believed allowable and indication of such allowance is earnestly requested.

Claim 2

Claim 2 is dependent on claim 1 and recites, "The method of Claim 1, further comprising if the event occurred, indicating that the event occurred at the device." It is noted that that, based on antecedent reference in the claims, claim 2 requires the indicating that the event occurrence take place at the subject device of the agreement between the device provider and the device user.

In rejecting claim 2, the Office Action alleges Dordick indicates that an event occurred at the device. Office Action, pg. 3. The Examiner cites paragraphs 10 and 11 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 10 of Dordick states,

Another aspect of the invention is an insurance system for indemnifying a service provider against quality of service penalties of a service level agreement between the service provider and a service purchaser. The insurance system includes an insurance policy provided by an insurer against the quality of service penalties. A premium in the system is made payable to the insurer by the service provider. In addition, compensation is paid by the insurer to the service provider for quality of service penalties occurring within terms of the insurance policy. The insurance system may include at least one risk metric to be monitored via a communication network, wherein the risk metric indicates a likelihood that the quality of service penalties will occur.

Paragraph 10 of Dordick describes an insurance system for indemnifying a service provider against quality of service penalties of a service level agreement. It is clear from a reading of paragraph 10 that there is no teaching or suggestion of indicating that an event occurred at the device.

Paragraph 11 of Dordick states,

A further aspect of the invention is a method of indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event. The insurance purchaser and insurance provider are coupled to a communication network, and the method includes a receiving operation for obtaining an insurance premium from the insurance purchaser. A monitoring operation is performed to monitor at least one risk metric via the communication network, wherein the risk metric indicates a likelihood that the specified event will occur. An adjusting operation adjusts the insurance premium according to changes in the at least one risk metric.

Paragraph 10 of Dordick describes a method of indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event. It is clear from a reading of paragraph 11 that there is no teaching or suggestion of indicating that an event occurred at the device.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 2. Thus, claim 2 is believed allowable and indication of such allowance is earnestly requested.

Claim 3

Claim 3 is dependent on claim 1 and recites, "The method of Claim 1, further comprising storing the agreement in the device." It is noted that that, based on antecedent reference in the claims, claim 3 requires the agreement is stored in the subject device of the agreement between the device provider and the device user.

In rejecting claim 3, the Office Action alleges Dordick stores the agreement in the device. Office Action, pg. 3. The Examiner cites item 110 and paragraphs 10 and 11 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Figure 1 of Dordick illustrates various components of an environment embodying a service agreement 110 between a service provider 104 and a service purchaser 106. There is no teaching or suggestion of storing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

Paragraph 10 of Dordick states,

Another aspect of the invention is an insurance system for indemnifying a service provider against quality of service penalties of a service level agreement between the service provider and a service purchaser. The insurance system includes an insurance policy provided by an

insurer against the quality of service penalties. A premium in the system is made payable to the insurer by the service provider. In addition, compensation is paid by the insurer to the service provider for quality of service penalties occurring within terms of the insurance policy. The insurance system may include at least one risk metric to be monitored via a communication network, wherein the risk metric indicates a likelihood that the quality of service penalties will occur.

Paragraph 10 of Dordick describes an insurance system for indemnifying a service provider against quality of service penalties of a service level agreement. It is clear from a reading of paragraph 10 that there is no teaching or suggestion of storing an agreement in a device.

Paragraph 11 of Dordick states,

A further aspect of the invention is a method of indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event. The insurance purchaser and insurance provider are coupled to a communication network, and the method includes a receiving operation for obtaining an insurance premium from the insurance purchaser. A monitoring operation is performed to monitor at least one risk metric via the communication network, wherein the risk metric indicates a likelihood that the specified event will occur. An adjusting operation adjusts the insurance premium according to changes in the at least one risk metric.

Paragraph 10 of Dordick describes a method of indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event. It is clear from a reading of paragraph 11 that there is no teaching or suggestion of storing an agreement in a device.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 3. Thus, claim 3 is believed allowable and indication of such allowance is earnestly requested.

Claim 4

Claim 4 is dependent on claim 1 and recites, "The method of Claim 1, further comprising enforcing the agreement at the device." It is noted that that, based on antecedent reference in the claims, claim 4 requires enforcing the agreement at the subject device of the agreement between the device provider and the device user.

In rejecting claim 4, the Office Action alleges Dordick enforces the agreement at the device. Office Action, pg. 3. The Examiner cites items 110

and 316, and paragraphs 3 and 4 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Figure 1 of Dordick illustrates various components of an environment embodying a service agreement 110 between a service provider 104 and a service purchaser 106. There is no teaching or suggestion of enforcing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

Similarly, item 316 of Figure 3B is block labeled "Compensate insurance purchase for loss." The description of this block states, "During this operation, the insurance compensates the insurance purchaser for the loss incurred as a result of the event occurrence, as specified in the insurance policy." Dordick, paragraph 41. The Applicants submit is no teaching or suggestion of enforcing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

Paragraph 3 of Dordick states,

Entities that rely on Internet communication or commerce for their day-to-day affairs may not only be interested in the type of service a service provider offers, but also the quality of its service. To attract these customers, service providers will often promise a quality of service level that, should they fall below, obligates the service provider to pay penalties to the customer. Such a promise is often expressed in a service level agreement between the service provider and the customer. Absent a service level agreement, a service provider may still be liable for service penalties by law as a result of its representations, advertising, or industry standards. Thus, the service provider may be exposed to quality of service liability as a result of either express or implied service agreements with its customers.

Paragraph 3 of Dordick describes service level agreements offered by service providers. The Applicants submit is no teaching or suggestion in this paragraph of enforcing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

Paragraph 4 of Dordick states,

Quality of service guarantees can come in many forms. A guarantee may specify how quickly or how often a technical assistant is made available to the customer. Thus, quality of service penalties may result from not having enough technical assistants immediately available to speak with customers. Penalties may also result from not having enough bandwidth to meet its customers' collective throughput level at a particular time. Regardless of the type of quality of service liability the service provider is exposed to, the amount of penalties paid by the service provider could mean the difference between success and failure for the service provider.

Paragraph 4 discusses quality of service guarantees and penalties in service agreements. Again, the Applicants submit is no teaching or suggestion in this paragraph of enforcing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 4. Thus, claim 4 is believed allowable and indication of such allowance is earnestly requested.

Claim 5

Claim 5 is dependent on claim 4 and recites, "The method of Claim 4, wherein enforcing the agreement includes disabling at least some of the capabilities of the device if the event occurred." It is noted that that, based on antecedent reference in the claims, claim 5 requires disabling capabilities of the subject device of the agreement between the device provider and the device user.

In rejecting claim 5, the Office Action alleges Dordick disables at least some of the capabilities of a device if an event occurred. Office Action, pg. 3. The Examiner cites items 314 and paragraph 27 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Item 314 of Figure 3B is block labeled "Has event occurred?" The description of this block states, "at query operation 314, it is determined that an event specified in the insurance policy has occurred." Dordick, paragraph 41. The Applicants submit is no teaching or suggestion of disabling at least some of the capabilities of a device if an event occurred, much less a subject device of an agreement between a device provider and a device user.

Paragraph 27 of Dordick states,

Thus, one embodiment of the present invention allows companies that are dependent on service agreements 110 (both service providers 104 and service purchasers 106) to buy insurance products to hedge this risk. The insurance products can be dynamic in the sense that they can be bought on the fly in response to changing conditions or anticipated events, such as variations in customer workload demand, bandwidth, performance bottle necks, hardware or software fails, etc. In some instances, the insurance provider 114 may sell the insurance products in advance for a fixed term, like traditional insurance, where

depending on the business being insured (i.e., service provider 104 or service purchaser 106), the insurance provider 114 takes into account details of the service agreement guarantees committed to by the service provider 104 or received by the service purchaser 106, along with a risk assessment model.

Paragraph 27 of Dordick discusses insurance products to hedge the risk service agreements. The paragraph makes no mention or suggestion of disabling at least some of the capabilities of a device if an event occurred, much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claims 1 and 4, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 5. Thus, claim 5 is believed allowable and indication of such allowance is earnestly requested.

Claim 6

Claim 6 is dependent on claim 4 and recites, "The method of Claim 4, wherein enforcing the agreement includes enabling at least some of the capabilities of the device if the event occurred." It is noted that that, based on antecedent reference in the claims, claim 6 requires enabling capabilities of the subject device of the agreement between the device provider and the device user.

In rejecting claim 6, the Office Action alleges Dordick disables at least some of the capabilities of a device if an event occurred. Office Action, pg. 3. The Examiner cites items 316 and paragraph 27 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Item tem 316 of Figure 3B is block labeled "Compensate insurance purchase for loss." The description of this block states, "During this operation, the insurance compensates the insurance purchaser for the loss incurred as a result of the event occurrence, as specified in the insurance policy." Dordick, paragraph 41. The Applicants submit is no teaching or suggestion of enabling capabilities of a device if an event occurred, much less a subject device of an agreement between a device provider and a device user.

Paragraph 27 of Dordick states,

Thus, one embodiment of the present invention allows companies that are dependent on service agreements 110 (both service providers 104 and

service purchasers 106) to buy insurance products to hedge this risk. The insurance products can be dynamic in the sense that they can be bought on the fly in response to changing conditions or anticipated events, such as variations in customer workload demand, bandwidth, performance bottle necks, hardware or software fails, etc. In some instances, the insurance provider 114 may sell the insurance products in advance for a fixed term, like traditional insurance, where depending on the business being insured (i.e., service provider 104 or service purchaser 106), the insurance provider 114 takes into account details of the service agreement guarantees committed to by the service provider 104 or received by the service purchaser 106, along with a risk assessment model.

Paragraph 27 of Dordick discusses insurance products to hedge the risk service agreements. The paragraph makes no mention or suggestion of disabling at least some of the capabilities of a device if an event occurred, much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claims 1 and 4, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 6. Thus, claim 6 is believed allowable and indication of such allowance is earnestly requested.

Claim 7

Claim 7 is dependent on claim 1 and recites, "The method of Claim 1, further comprising representing the agreement as a Boolean expression of at least one condition, the condition based on the parameter."

In rejecting claim 7, the Office Action alleges Dordick represents an agreement as a Boolean expression of at least one condition, the condition based on a parameter. Office Action, pg. 3. The Examiner cites paragraphs 32 and 33 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 32 and 33 of Dordick state,

[0032] In FIGS. 3A and 3B, flowcharts for indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event, as contemplated by one embodiment of the present invention, are shown. It should also be remarked that at least some of the logical operations shown may be implemented (1) as a sequence of computer executed steps running on a computing system and/or (2) as interconnected machine modules within the computing system. The implementation is a matter of choice dependent on the performance requirements of the system implementing the invention. Accordingly, the logical operations making up the embodiments of the present invention described herein are referred to alternatively as operations, steps, or modules.

[0033] Operational flow begins with receiving operation 302. During this operation, the insurance provider receives a request for insurance coverage from the insurance purchaser. The request is typically accompanied with or followed by information about the insurance coverage required by the insurance purchaser, and includes the event or events that the insurance purchaser wishes to be protected against, as well as the amount of protection required. In the example where the insurance purchaser is a service provider, the information received may be a request for insurance against quality of service penalties. The information may specify the amount of insurance coverage, deductibles and premiums. Furthermore, the information may describe the service provider's infrastructure, customer usage, service agreements, and various other attributes that may affect the service provider's exposure to quality of service penalties. After the receiving operation 302 is completed, flow continues to providing operation 304.

The Applicants respectfully submit there is no mention or suggestion in paragraphs 32 and 33 of Dordick of representing an agreement as a Boolean expression of at least one condition, the condition based on a parameter.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 7. Thus, claim 7 is believed allowable and indication of such allowance is earnestly requested.

Claim 9

Claim 9 recites, "The method of Claim 8, further comprising indicating violation of the agreement on the device." It is noted that that, based on antecedent reference in the claims, claim 9 requires indicating violation of the agreement on the subject device of the agreement between the device provider and the device user.

In rejecting claim 9, the Office Action alleges Dordick enforces the agreement at the device. Office Action, pg. 4. The Examiner cites paragraph 37 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 37 of Dordick states,

In one embodiment of the invention, the insurance provider automatically monitors the insurance risk metrics at regular intervals via the network. For example, the insurance provider may check a risk metric's value every minute or every hour. In another embodiment the insurance provider is automatically notified when the metrics have significantly changed. For example, the insurance provider may be automatically notified when a risk metric has changed beyond a threshold percentage of its value.

Paragraph 3 of Dordick describes a capability of an insurance provider monitoring insurance risk metrics at regular intervals via a network. The Applicants submit is no teaching or suggestion in this paragraph of indicating violation of an agreement on a subject device of an agreement between the device provider and the device user.

For at least this reason, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 9. Thus, claim 9 is believed allowable and indication of such allowance is earnestly requested.

Claims 8 and 10-13

Claims 8 and 10-13 are dependent on and further limit claim 1. Since claim 1 is believed allowable, claims 8 and 10-13 are also believed allowable for at least the same reasons as claim 1.

Claim 14

Claim 14 recites, in part, "A method for embedding an agreement between a software module provider and a software module user in a software module." As discussed above for claim 1, Dordick does not teach or suggest embedding an agreement between a software module provider and a software module user in a software module.

For at least these reasons, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 14. Thus, claim 14 is believed allowable and indication of such allowance is earnestly requested.

Claim 15

Claim 15 recites, in part, "a representation of the agreement embedded in the device." As discussed above for claim 1, Dordick does not teach or suggest embedding a representation of an agreement in a device.

For at least these reasons, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 15. Thus, claim 15 is believed allowable and indication of such allowance is earnestly requested.

Claim 16

Claim 16 is dependent on claim 15 and recites, "The device of Claim 15, wherein the agreement is legally unenforceable." The Office Action rejects claim 16 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pg. 4. The Applicants respectfully disagree with this position and request clarification

from the Examiner of where in claims 1-13 the subject matter of claim 16 is recited.

Claim 17

Claim 17 is dependent on claim 15 and recites, "The device of Claim 15, wherein the determining module is configured to determine if the event is likely to occur in the near future, and the alert module is configured to indicate that the event is likely to occur in the near future." The Office Action rejects claim 17 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pg. 4. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 17 is recited.

Claim 18

Claim 18 is dependent on claim 15 and recites, "The device of Claim 15, further comprising a data aggregation module configured to aggregate the data from the at least one parameter." The Office Action rejects claim 18 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pg. 4. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 18 is recited.

Claims 19 and 20

Claims 19 and 20 are dependent on and further limit claim 15. Since claim 15 is believed allowable, claims 19 and 20 are also believed allowable for at least the same reasons as claim 15.

Claims 21-31

Claims 21-31 were rejected "for the same rationale as claims 1-13." Office Action, pg. 4. Thus, the Applicants submit claims 21-31 are allowable for at least the same reasons given above for claims 1-13.

CONCLUSION

In view of the forgoing remarks, it is respectfully submitted that this case is now in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Dated: July 8, 2008

Respectfully submitted,

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